

EXHIBIT 5

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21 UNITED STATES DISTRICT COURT
22 NORTHERN DISTRICT OF CALIFORNIA
23 OAKLAND DIVISION

24 INTERTRUST TECHNOLOGIES
25 CORPORATION, a Delaware corporation,

26 Plaintiff,

27 v.

28 MICROSOFT CORPORATION, a
Washington corporation,

Defendant.

MICROSOFT CORPORATION, a
Washington corporation,

Counterclaimant,

v.

INTERTRUST TECHNOLOGIES
CORPORATION, a Delaware corporation,

Counter Claim-Defendant.

Case No. C 01-1640 SBA (MEJ)

Consolidated with C 02-0647 SBA (MEJ)

**REPLY TO INTERTRUST'S
OPPOSITION TO MICROSOFT'S
BRIEF IN SUPPORT OF MOTION
FOR SUMMARY JUDGMENT THAT
CERTAIN "MINI-MARKMAN"
CLAIMS ARE INVALID FOR
INDEFINITENESS**

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1 **I. INTRODUCTION AND SUMMARY OF ARGUMENT**

2 InterTrust's opposition brief throws up a storm of noise, diversion and straw
3 arguments that should not distract this Court's attention from the very simple question on which
4 the defense of indefiniteness will be determined: Whether the claim has sufficiently definite
5 scope that a person of ordinary skill in the art can understand what it means in light of the
6 specification and thereby determine what is outside its scope. *Union Pac. Resources Co. v.*
7 *Chesapeake Energy Co.*, 236 F. 3d 684, 692 (Fed. Cir. 2001). For each of the eleven claims
8 challenged on this motion, the answer must be, "No."

9 What emerges from InterTrust's opposition brief are two important points upon
10 which the parties agree: First, "secure" is a relative term that has only a vague, general meaning
11 in the art, which can mean different things in different contexts. Second, to determine what is
12 "secure" in any particular context one of skill in the art needs specific criteria. The essential
13 problem with InterTrust's patents is that they fail to provide the needed context and they fail to
14 adopt any particular criteria, leaving both critical steps for others to guess at. They further fail to
15 define "secure" expressly, and they fail to define it implicitly by identifying any particular
16 technology used to achieve security. When one turns to the Big Book for resolution of the
17 resulting ambiguity, it is like coming to a trailhead with 50 signs labeled "secure," but each
18 pointing in a different, inconsistent, and often times contradictory direction.

19 The term "secure" is unusual in that it is a label characterizing a multidimensional
20 condition of something – a result achieved amid constantly changing circumstances. It is an
21 inherently subjective concept that can be evaluated in many different ways (with correspondingly
22 different outcomes). Labels set forth in patent claims, however, must be subject to an objective
23 evaluation. Otherwise, it is impossible for the public to evaluate the scope of the claim.

24 The *claims* fail to recite either context or criteria. The traditional places to which
25 one turns to correct this shortcoming are equally unavailing. The evidence from the parties'
26 experts, corroborated by third party accounts, confirms that definite context and criteria is critical
27 information for anyone having skill in this art, and it is information that merely having skill in the
28 art does *not provide*. To the contrary, persons of skill in the art are aware of a multitude of

1 possible ways of distinguishing between something that is “secure” and something that is “not
2 secure.” Finally, *the specification* is equivocal on everything except what “VDE” can do, and the
3 file history offers no resolution. Indeed, the specification compounds the problem because it
4 mentions but fails to adopt any of the many possible security contexts and criteria. After reading
5 the nearly one thousand pages of Big Book text, the person of ordinary skill in the art would have
6 no idea what, for example, a claim’s “secure container,” “secure memory,” or “secure process”
7 must protect, or against what threats, or to what degree, or by what criteria such evaluations
8 should be conducted. The evidence from the parties’ experts, corroborated by third party
9 accounts, confirms that specific context and criteria are critical information for anyone having
10 skill in this art, and it is information that merely having skill in the art does *not provide*. It is for
11 these reasons that the mini-*Markman* claims are indefinite and should be declared invalid.

12 **II. “SECURE” AS USED IN THESE MINI-MARKMAN CLAIMS RENDERS THEM** 13 **INDEFINITE**

14 **A. A Person of Skill Reading the Claims Cannot Tell What “Secure” Means in** 15 **Light of the Relevant Art**

16 One of skill in the art reading the claims finds references to “secure memory,”
17 “secure database,” “secure container,” “securely assembling,” and “level of security,” but no
18 explanation of what is meant by “secure” other than the promises made for the “present
19 invention,” “VDE.” Looking to the art as a whole for guidance offers no comfort. The term, as
20 *InterTrust* admits, has only a very general meaning – that some designs, techniques or
21 mechanisms are used to protect certain properties against some kind of attack or adversarial
22 conditions. *InterTrust* Opp., at 4 (quoting Prof. Mitchell’s definition as the one on which both
23 parties’ experts “agree”). This definition manifestly lacks a clear boundary. Which designs,
24 techniques, mechanisms, properties, attacks, and or conditions are intended? The claims point to
25 no criteria in the art that would answer that question.

26 Both parties’ experts agree that criteria are needed to reach a precise understanding
27 of “secure.” The testimony of *InterTrust*’s own expert, cited in *Microsoft*’s opening brief, fully
28 supports the proposition that the term needs further specification of parameters and criteria in

1 order to be sufficiently definite.¹ Microsoft Brief, at 4. InterTrust's expert now adds that to apply
2 the general meaning of "secure" "to a particular product or system, it is necessary to understand
3 the context of that product or system." Reiter Decl., at ¶ 3. Dr. Reiter also admits that there are
4 "several recognized methodologies for determining if computer products are 'secure'" and that
5 "[c]omputer security professionals routinely use such methods to determine if products or
6 methods are 'secure.'" Opp., at 3; Reiter Decl., at ¶ 3. InterTrust even approvingly characterizes
7 Dr. Mitchell's testimony as meaning that one must know the protected properties and potential
8 attacks to determine if a particular system is "secure," and that recognized methodologies are
9 used to perform this investigation. *Id.* at 5. The Mitchell declaration, scholarly articles, and
10 third-party witnesses have provided evidence to the same effect. *Id.*; Mitchell Decl., at 4-11.²

11 It should be noted here that InterTrust's allegation that Prof. Mitchell did not try to
12 understand the terms in the context of the claims is based on a misrepresentation of his testimony.
13 As Prof. Mitchell clearly explained, for each term and phrase in question, he "tried to look at its
14 meaning in three different ways" – whether the term by itself has a commonly understood specific
15 meaning, whether the term is clear "in the context of the claim," and whether the patent
16 specification provides "any further information." (Mitchell Depo. at 294). In its brief, however,
17 InterTrust cut off the quotation of Prof. Mitchell's testimony right before he gave an answer that
18 contradicted the proposition for which InterTrust quoted him:

19 A. I – I tried to explain a little bit earlier that my task to this point
20 in this case has been to, first of all, understand the patent's specs
21 and so on, and, second, in particular to this declaration, think about
22 these particular phrases, what they mean in general, what they
23 appear to mean in the claims, and ponder the question of whether
the specification gives us additional useful information so that I
could pin down the meaning of these terms in a useful and
meaningful way.

24 ¹ InterTrust erects Prof. Mitchell's effort to summarize the different axes of security into a classic
25 straw man. Calling it a "test" – a term nowhere used by Microsoft – InterTrust reasons that,
26 because this "test" is not recognized as such in the art, it sheds no light on the definiteness of
InterTrust's patent claims.

27 ² For this reason, InterTrust's lengthy argument that "secure" has a meaning in the art is beside
28 the point. InterTrust Opp., at 2-3. As Microsoft stated in its opening brief, "while
communicating a general or conceptual meaning, the term 'secure' lacks any precise, uniform
definition to inform a person of skill in the art what it means *unless a number of questions are
answered.*" Microsoft's Brief in Support of Motion, at 3 (emphasis added).

1 In that process, I have read the claims and have some understanding
2 of what they appear to promise and what they seem to mean in
3 general. But as far as doing further detailed analysis of what is
4 exactly required by each claim, I haven't really studied that in -- in a
5 proper way yet.

6 Wesenberg Reply Decl., Exh. A (Mitchell Depo., Vol. 2, at 299:1-17).

7 Because the challenged claims use "secure" without providing specific parameters
8 or criteria or referencing any in the art, one cannot determine their scope by reading them. A
9 person of ordinary skill is left unable to define "secure" in light of the art and thus unable to
10 understand the claims precisely enough to know what is in their scope.

11 **B. The Specification Does Not Select Any Criteria for Evaluating "Secure",**
12 **Though It Refers to Some**

13 Faced with a vague and general "ordinary" meaning, we look to the patent
14 specifications to see if they point to any of the criteria recognized in the art. InterTrust and
15 Microsoft have identified some of the well-known "off-the-shelf" standards for determining
16 "security," including the Common Criteria for Information Technology Security Evaluation, the
17 Trusted Computer System Evaluation Criteria ("TCSEC"), and Federal Information Processing
18 Standard 140-1 ("FIPS 140-1"). InterTrust Brief, p. 3; Reiter Decl., pp. 3-7. The fatal problem
19 with InterTrust's specifications is that while they mention some of these standards, they adopt
20 none of them. Nowhere is there a clear indication that a particular standard or identified criteria
21 is the one to follow. The specification treats them as optional and applicable, if at all, only to a
22 small part of the universe of the patent.

23 The TCSEC, for instance is mentioned in one column of the '193 patent, in a
24 discussion of the possible use of VDE to support document management for a large organization.
25 In a list of examples of how "VDE-enforced control capabilities" can be used to manage
26 documents, the specification states that one particular type of document transmission channel and
27 one type of storage device "could be" set up with restrictions that would satisfy the Device Labels
28 requirement of the TCSEC. '193, col. 279:45-60. But these are just two examples (out of nine)
of uses to which VDE can supposedly be put in one type of customer context, out of a great many
others promised in the patent. Nowhere does the patent state or even suggest that TCSEC or any

1 part of it is meant to provide criteria to define “secure” throughout the patent, and InterTrust does
2 not make that argument now.

3 Likewise, the ‘721 specification mentions the FIPS-186 “Digital Signature
4 Standard,” but only as one possible methodology for evaluating the “security” of a digital
5 signature. Again, InterTrust does not even argue that this is the standard a person of skill should
6 use to evaluate whether something is “secure,” but merely that one could do so.

7 **C. The Specification Does Not Define “Secure” for Purposes of the Patent**

8 Lacking a known criteria or a specified new criteria, an otherwise indefinite claim
9 can be saved if the specification defines the proper measure of the problem term. Unfortunately,
10 the 900+ pages of the patent specification point in so many different directions that it is
11 impossible to know which apparent definition of “secure” to use. The patent does contain a great
12 deal of verbiage about security methods and degrees. But its discussion of these issues is
13 tantamount to a recitation of almost everything security could possibly mean or include, including
14 unbounded references to whatever is not expressly recited in the patent.

15 **1. The Specification Does Not Define “Secure” Explicitly**

16 The patent never explicitly defines what “secure” means, either lexically or by
17 outlining its own security policy or set of security criteria, a fact which InterTrust has not
18 disputed.

19 **2. The Specification Does Not Define “Secure” by Functional Description**

20 The specification also fails to give “secure” a precise and unambiguous meaning
21 by describing it functionally. That is, no clear and precise meaning of “secure” can be derived
22 from the technological features disclosed in the specification. Although the specification contains
23 a voluminous recitation of detail, that detail itself describes so many purportedly different levels
24 of “security” that it is impossible to tell which technological features suffice to make a system
25 “secure” in any particular instance. (As discussed below, it is inconsistent for InterTrust to argue
26 that the specification provides the detail needed to make “secure” definite enough to determine
27 what infringes, when it has excluded any such detail from its proposed Markman definition of the
28 same term.)

1 The discussion of encryption mechanisms cited by InterTrust as supposed
2 evidence of secure's definiteness exemplifies this. InterTrust argues that the '193 patent
3 "contains a passage contrasting 'highly secure' encryption algorithms with 'extremely secure'
4 algorithms, and explicitly identifies each type of algorithm, including explaining circumstances
5 under which each should be used." InterTrust's opposition brief blithely reassures the reader that
6 "both 'highly secure' and 'extremely secure' algorithms are 'secure.'" But these phrases clearly
7 denote different degrees of security. To which level do the claims refer when they employ
8 "secure"? InterTrust's answer that the specification tells one which "secure" mechanisms to use
9 under which circumstances is untrue. The "highly secure" algorithm in this example is described
10 simply as a "'bulk encryption/decryption technique.'" '193, col. 67:18-19. Elsewhere, the patent
11 states that VDE "does not require any specific algorithm ... for bulk encryption/decryption."
12 '193, Col. 201:27-29. More importantly, for both the "highly secure" and "extremely secure"
13 cases, the measures mentioned are described as "preferable." *Id.*, col. 67:18, 21. This implies
14 that there are circumstances under which the "preferable" option would not be employed, raising
15 the question of what those circumstances are, who would make the decision, and how.

16 The next example cited by InterTrust begins to answer that question: in fact,
17 "secure" is not evaluated by anything intrinsic to the patent, but by a subjective and unpredictable
18 decisionmaking process. A discussion of encryption techniques that InterTrust offers as proof of
19 the specificity with which the patent allegedly endows "secure," InterTrust Opp., at 6; '193, col.
20 201:63-202:12, is immediately preceded by this explanation:

21 VDE 100 provided by the preferred embodiment accommodates
22 and can use many different key lengths. The length of keys used by
23 VDE 100 in the preferred embodiment is determined by the
24 algorithm(s) used for encryption/decryption, *the level of security*
25 *desired*, and throughput requirements. Longer keys generally
26 require additional processing power to ensure fast encryption/
decryption response times. Therefore, there is a tradeoff between
(a) security, and (b) processing time and/or resources. Since a
hardware-based PPE encrypt/decrypt engine 522 may provide faster
processing than software-based encryption/decryption, the
hardware-based approach may, in general, allow use of longer keys.

27 '193, Col. 201:50-62. There is no constraint placed on the "level of security desired" – it is up to
28 the user or system designer (or someone – the patent does not say whom) to balance security

1 against their subjectively perceived costs in deciding what key lengths to use. The entire
2 discussion of key lengths that follows is therefore dependent on a preference external to the
3 patent. It is not enough to give technical details about key lengths, because whatever key length a
4 person of skill in the art might choose or encounter fails to answer the question whether the
5 product or activity in question is or isn't "secure" as used in the claims.

6 **III. INTERTRUST'S EFFORTS TO DEFEND "SECURE" REVEAL THE**
7 **INDEFINITE MEASURE OF SECURITY IMPLICIT IN THE PATENT**

8 InterTrust's proposed solutions to the patent's lack of a standard for "secure" – its
9 Markman definition and or a "commercially reasonability" standard – reveal precisely why the
10 term is indefinite. The evidence confirms that "secure" as used in the claims has no fixed, precise
11 meaning and is constrained by no criteria.

12 **A. The Proposed Markman Definition Is Indefinite**

13 Contrary to its concession of the need for criteria, InterTrust asserts that its
14 proposed *Markman* definition of "secure" is sufficiently definite. InterTrust Opp., at 4.
15 InterTrust's opposition brief omits, however, a crucial sentence within its proposed definition:
16 "Security is not absolute, but designed to be sufficient for a particular purpose." Joint Claim
17 Construction Statement, Exh. A, at 1. The definition states no "purpose," leaving the person of
18 skill in the art completely in the dark as to how much security is needed, or for what, as well as
19 how to measure it.

20 **B. The Proposed Standard of "Commercial Reasonableness" Is Indefinite and**
21 **Unsupported by the Patent**

22 InterTrust's Opposition brief suggests an alternative definition for "secure" –
23 "commercial reasonability." Having admitted the need for criteria, and challenged to show where
24 the patents provide such criteria, InterTrust asserts that "[t]he information included in the
25 InterTrust patents includes guidance regarding how security should be measured, including the
26 statement that security should be based on a commercially reasonable standard." Opp., 3-4. Dr.
27 Reiter elaborates in his declaration, reiterating the need for context and criteria, but stating that
28 "computer security professionals routinely apply a commercial reasonability standard in building

1 security into real-world products and in determining whether real-world products or processes are
2 'secure.'" Reiter SJ Decl., at 12, 18.

3 If the "commercial reasonability" standard were in fact supported by the patent or
4 the evidence, it would still leave the claims indefinite. But the Court need not even consider that
5 question, because InterTrust's expert, Dr. Reiter, admits that the "commercially reasonable"
6 standard referred to in his second Declaration differs from InterTrust's proposed *Markman*
7 definition. When asked if he drafted the above-quoted sentence about computer security
8 professionals "routinely apply[ing] a commercial reasonability standard," Dr. Reiter responded
9 that he had neither drafted nor dictated it, saying only that he "remember[s] discussing issues like
10 this with InterTrust before this was drafted, as far as I know, because I don't actually know when
11 it was drafted." Reiter Depo., 4/17/03, p. 420:1-20 attached to Wesenberg Reply Decl., Exh. B.
12 That led to the following exchange:

13 Q: You recall discussing the opinion that computer security
14 professionals routinely apply a commercial reasonability standard
15 with InterTrust before you arrived at InterTrust and were given the
16 draft of this declaration that's been marked as Exhibit 69?

16 A. Certainly I remember discussing security is meant to be
17 sufficient for a given purpose or a given set of threats and that
18 requirements for commercial systems would be different than for
19 other types of systems. I don't know if I used exactly the words
20 commercial reasonability standard, though.

19 Q. Do you understand "commercial reasonability standard" to
20 be synonymous with "designed to be sufficient for a particular
21 purpose"?

21 A. I don't think I would say they're synonymous.

22 Q. How do they differ?

23 A. Commercial reasonability indicates a particular type of
24 purpose or, you know, a particular – I should say maybe set of
25 threats to which protection mechanisms should be robust or against
26 which they should be robust.

25 Reiter Depo., 4/17/03, pp. 420:21-421:22, Wesenberg Reply Decl., Exh. B. "Commercial
26 reasonability" thus not only means something different from InterTrust's proposed *Markman*
27 definition, it also (unlike InterTrust's proposed *Markman* definition) gives at least a general
28 indication what kinds of threats the system is to be secured against.

1 In fact, the commercial reasonability standard appears nowhere in the patent. Tellingly,
2 Dr. Reiter's declaration does not assert that the patent teaches "commercial reasonability" – only
3 InterTrust's brief makes that claim, citing two excerpts from the specification as support.
4 InterTrust Opp., at 4 n.4. But the cited specification language says nothing about how to evaluate
5 or define "reasonability." Rather, it refers to "sufficient security (sufficiently trusted) for the
6 intended commercial purposes" and states that the level of security **depends on "the commercial**
7 **requirements of particular markets or market niches, and may vary widely."** '193, Col.
8 45:39-45, 49:59-62 (emphasis added). These statements effectively admit that "secure" is
9 indefinite as used in the claims.

10 **C. InterTrust Has Effectively Admitted that Secure Is Indefinite**

11 The patent language that InterTrust cites as support for the "commercial
12 reasonability" standard acknowledges that in these patents the only criteria of "secure" "depends
13 on the commercial requirements of particular markets or market niches, and may vary widely."
14 '193 patent, Col. 49:61-62, quoted in Joint Claim Construction Statement, Exh. C, item 19(B),
15 19(J), cited in InterTrust Opp., at 4 n.4. This admits indefiniteness, because no measure or
16 method is identified which would let people of skill in the art precisely and reliably reach the
17 same conclusion whether something is "secure" in those admittedly widely varying markets –
18 especially where each of those markets consists of many different companies and people, and
19 many possible different standards and "requirements."

20 InterTrust's brazenness in taking this position is apparently a function of its
21 confidence that it can overwhelm Microsoft and the Court by citing to the numbing abundance of
22 technical description in its gargantuan patents. The mere presence of voluminous description of
23 possible technologies does not provide the needed measure.

24 **IV. INTERTRUST COINED TERMS "PROTECTED PROCESSING
25 ENVIRONMENT" AND "HOST PROCESSING ENVIRONMENT" AS USED IN
26 ITS PATENTS LACK THE NECESSARY DEFINITENESS TO ONE OF
ORDINARY SKILL IN THE ART**

27 Like its arguments regarding "security," InterTrust's arguments regarding
28 Protected Processing Environment ("PPE") and Host Processing Environment ("HPE") miss the

1 mark. In its Opposition, InterTrust simply ignores its burden of defining coined terms with
2 "precision." *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F. 3d 1563, 1570 (Fed. Cir.
3 1997). Instead it argues that HPE and PPE receive "extensive discussion in the specification."

4 Whatever the extent of the discussion, InterTrust points to no instance where these
5 terms are clearly and *precisely* defined. Microsoft's primary contention is that when used, the
6 coined phrases HPE or PPE, are used inconsistently, sometimes contradictorily and nearly always
7 shrouded in qualifying and conditional language. The passages from the '193 specification
8 attached to Dr. Reiter's declaration illustrate these defects. First, the nature of, and relationship
9 between, "SPE", "PPE" and "HPE", is indeterminate. In a passage from the '193 specifications
10 and cited by InterTrust's expert, the following relationship is described:

11 ROS 602 in this example also includes one or more Host Event
12 Processing Environment ("HPEs") 655 and/or one or more Secure
13 Event Processing Environments ("SPEs") 503 (these environments
14 may be generically referred to as "Protected Processing
15 Environments" 650). (Col. 79, 30-35)

16 It can be surmised from this that reference to a PPE could mean either SPE or
17 HPE. The specification, however, identifies that "HPEs" may be provided in two types,
18 "Secure" and "Not Secure," and InterTrust leaves one to guess which is which in any given
19 instance. Indeed, InterTrust admits that its proposed definition of HPE does not acknowledge this
20 schism, yet InterTrust offers only a circularity as a remedy: that non-secure HPEs be defined to
21 be HPEs that are not secure.

22 Any attempt to distinguish these terms by their structural or functional
23 characteristics is futile. When text is actually committed to discussing a "PPE", "SPE" or "HPE"
24 the qualities and/or attribute assigned each are merely optional. In the text following the
25 introduction of the terms PPE and HPE (Col. 79, 31-35) the specification identifies no fewer than
26 four attributes that "may" be aspects of an SPE or HPE. "HPEs and SPEs are self-contained
27 computing and processing environments that *may include* their own operating system kernel,
28 ... *may process* information in a secure way, ... they *may* each perform ... they *may* each offer ...".
Reiter Decl., Ex. G., p. 2 (Col. 79, 36-46). (Emphasis added.) As demonstrated in this example,
representations about functional and design characteristics of HPE's and PPE's are frequently

1 qualified with the term “may be” or “can be.” The first two full paragraphs of Reiter Ex. G at p. 3
2 when referring to HPEs or SPEs use “may,” “may be,” “can be” or “could” fifteen times. Every
3 sentence but one does so. The constant use of such qualifying language leaves one irredeemably
4 confused as to the nature and characteristics of the PPEs and HPEs. Again, there is plenty of
5 verbiage directed generally at these terms but they remain undefined, and certainly cannot be
6 understood with anything approximating “precision.”

7 InterTrust’s argument that Professor Mitchell “has no difficulty understanding
8 what the term [PPE] means” is both wrong and of no consequence. Microsoft has never disputed
9 that one of ordinary skill in the art would be able to surmise what these coined terms *might*
10 suggest when dissected into their component parts. The section of the Mitchell declaration cited
11 by InterTrust is under the caption “what the claim appears to promise.” This standard neither
12 purports to, and does not, comport with the requirement of 35 U.S.C. § 112(2).

13 V. ARGUMENT

14 A. The Lack of Criteria or Parameters for “Secure” Render It Indefinite

15 InterTrust’s concession that persons of skill in the art require criteria to understand
16 “secure” with any precision, and that there are many different possible sets of criteria, greatly
17 simplifies the analysis in this case. In *Amgen v. Hoechst Marion Roussel, Inc.*, the Federal Circuit
18 held that claim language that could be measured by multiple recognized standards failed for
19 indefiniteness where the written disclosure named several standards but failed to specify which
20 one was to be used. 314 F.3d 1313, 1341-42 (Fed. Cir. 2003). Different methods of purifying
21 human urinary erythropoietin (“uEPO”) would produce samples with different glycosylation,
22 which meant that the claim limitation “having glycosylation which differs from that of human
23 uEPO” was a “moving target.” *Id.* at 1340, 1341 (quoting lower court). Finding that the
24 specification of the patent “does not direct those of ordinary skill in the art to a standard by which
25 the appropriate comparison can be made,” the Court held that “such ambiguity in claim scope is
26 at the heart of the definiteness requirement of 35 U.S.C. § 112 ¶ 2,” and affirmed the lower
27 court’s finding of indefiniteness. *Id.*, at 1341, 1342. Similarly, the failure of the InterTrust
28 patents to choose from among the many different standards by which “secure” could be

1 measured, or to specify clear criteria of its own, renders the claims containing the term “secure”
2 and its variants indefinite.

3 **B. Indexing a Claim Term to Market Conditions Creates Impermissible**
4 **Indefiniteness**

5 Instead of providing a standard, InterTrust has adopted the position that “secure”
6 in this patent “depends on the commercial requirements of different markets or market niches,
7 and may vary widely.” That ‘criterion’ is an unpredictable, moving target, much like the claim
8 term in *Ex parte Brummer*, 12 U.S.P.Q.2d 1653 (B.P.A.I. May 11, 1989). The term at issue in
9 that case depended not on any objectively ascertainable feature, but on the label the manufacturer
10 chose to place on the bicycle reflecting its subjective conception of the customer for whom the
11 product was intended. *Id.*, at 1655. InterTrust’s argument that this case is more like
12 *Orthokinetics v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986) is fallacious. In
13 *Orthokinetics*, the term that depended on a factor outside the patent was a length parameter – a
14 one-dimensional variable, so to speak. More importantly, it was not subjective. One of ordinary
15 skill in the art building the claimed travel chair “would easily have been able to determine the
16 appropriate dimensions” by measuring the particular automobile. *Id.* at 1576. The Court
17 therefore found it unnecessary to require the claims to list “all possible lengths corresponding to
18 the spaces in hundreds of different automobiles.” *Id.* In *Brummer*, no amount of “listing” in the
19 patent could possibly do the trick, because the terms on which the claim scope depended were
20 subjective – the manufacturer’s view of whom the bicycle was intended for, and the
21 characteristics of the rider. Similarly, in this case, a person of skill in the art cannot possibly
22 know what a particular customer, market or market niche will deem sufficiently “secure” until
23 after it has sold the product.

24 Indeed, the fact that one cannot determine the scope of a claim until a product is
25 first manufactured and sold demonstrates that the terms employing “secure” are also indefinite
26 under the principle of *STX, Inc. v. Brine, Inc.*, 37 F. Supp. 2d 740 (D. Md. 1999), *aff’d* on other
27 grounds, 211 F.3d 588 (Fed. Cir. 2000). In that case, subjective claim language describing a
28 lacrosse stick (“improved handling and playing characteristics”) would require one to play with

1 the stick in order to determine whether it possessed the limitation and therefore infringed. "The
2 notion that one reasonably skilled in the art would have to infringe the patent claim in order to
3 discern *the boundaries of the claim* is repugnant to long-standing principles of patent
4 jurisprudence." *Id.*, at 755. Here too, one would have to manufacture and sell the product to
5 determine whether it would enjoy market success and would thus have "sufficient security for the
6 intended commercial purposes."

7 **C. "Secure" Must Be Definite Because It Is Essential to VDE**

8 InterTrust assails Microsoft for taking the position that the central importance of
9 "secure" to VDE renders it crucial that the term be sufficiently definite. InterTrust Opp., at 20-
10 21. Contrary to InterTrust's argument, Microsoft did not assert a lower standard of proof of
11 indefiniteness; it sought to foreclose any such argument that InterTrust might make. InterTrust's
12 own reading of *Exxon* confirms that noncritical limitations can sometimes be expressed in
13 functional terms, while critical limitations cannot. Moreover, InterTrust's denial that its expert
14 testified that security is "essential to VDE" is false. InterTrust Opp., at 21-22. Asked about
15 "security," Dr. Reiter answered as follows: "I believe it's an essential aspect of VDE as described
16 in the specification, or in the sense that certainly the authors invest a lot of time on questions of
17 security, and so I think that's probably what they had in mind." Wesenberg Reply Decl., Exh. D
18 (Reiter Depo., 2/28/03, at 23:16-20).³ "Security" is a critical limitation, and must be sufficiently
19 definite.

20 **D. The Use of "Secure" in Other Patents (and Other Contexts) Is Completely**
21 **Irrelevant to Whether the Claims at Issue Are Definite**

22 It is a well-known aspect of indefiniteness case law that the same terms are held
23 indefinite in some cases, and definite in others. Thus, the question of whether secure may have
24 been used with sufficient definiteness in other patents, articles, etc., is irrelevant to whether it is
25 sufficiently definite here. In holding that a claim using the term "about" was indefinite, the
26 Federal Circuit warned: "In arriving at this conclusion, we caution that our holding that the term
27

28 ³ Microsoft's citation of this statement was off by five lines in the opening brief, the citation
starting at line 21 instead of line 16 on the same page.

1 'about' renders indefinite claims 4 and 6 should not be understood as ruling out any and all uses
2 of this term in patent claims. It may be acceptable in appropriate fact situations, even though it is
3 not here." *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1218 (Fed. Cir.
4 1991). Microsoft has never argued that "secure" cannot be used with sufficient definiteness, only
5 that InterTrust's patents fail to do so. InterTrust's arguments about Microsoft's use of "secure" in
6 its patents are irrelevant, as well as mistaken. (For example, the Slivka '671 patent asserted in
7 this case stands in marked contrast to InterTrust's use of "secure" in the claims at issue on this
8 motion, not least because the Slivka '671 patent sets forth a clear standard by which secure or not
9 secure can be evaluated).

10 1. The Non-Patent Documents that Employ the Term Are Not Required
11 to Satisfy 35 U.S.C. § 112

12 Equally irrelevant is InterTrust's argument that "secure" is used in myriad
13 publications and other contexts without the specification of every parameter. Microsoft agrees
14 that "secure" is used in the art in many different ways, some quite vague. That is precisely why it
15 is necessary to specify what is meant when using the term in a patent claim. Patent claims must
16 satisfy 35 U.S.C. § 112(2); the publications InterTrust cites need not. (It is worth noting,
17 however, that the only Microsoft publication provided to the Court by InterTrust uses the
18 Common Criteria to evaluate security – in telling contrast to InterTrust's pervasive failure to
19 identify a definite standard or measure by which "secure" can be evaluated by one of skill in the
20 art. *See Reiter SJ Decl., Exh. J*).

21 VI. INTERTRUST'S EFFORT TO INCORPORATE BY REFERENCE WAS
22 INEFFECTIVE

23 Patent Office practice surrounding incorporation by reference attempts to balance
24 1) the need to provide the public a complete written description of the patent (*see, e.g.*, 35 U.S.C.
25 § 112) with 2) "economy, amplification, or clarity of exposition" achieved by allowing lengthy
26 references to be incorporated by reference into an application under certain circumstances. *Ex*
27 *parte Schwarze*, 151 USPQ 426 (B.P.A.I. 1966); *see* MPEP § 608.01(p). To meet this balance,
28 the Patent Office has directed that: "essential" material may only be incorporated by reference to

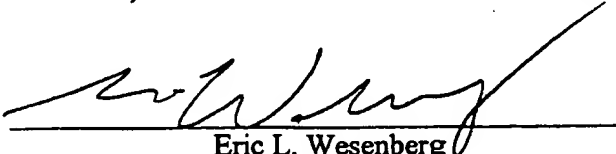
1 an issued U.S. Patent or a published U.S. Patent Application. On the other hand, "nonessential
2 material" may be referred to in a variety of ways. See MPEP § 608.01(p). Whether material has
3 been incorporated by reference is a question of law. *Advanced Display Sys., Inc. v. Kent State*
4 *University*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). InterTrust does not deny that the Big Book
5 material is essential material. The '683, '721, and '861 patents all purport to incorporate the "big
6 book" by reference to the unpublished patent application. For example, the '721 states, "This
7 application is related to commonly assigned copending application Ser. No. 08/388,107 of Ginter
8 et al. . . . We incorporate by reference, into this application, the entire disclosure of this prior-
9 filed Ginter et al. patent application." (721: 1:7-16; cf. 683: 1:7-23; 861 1:7-11). At the time that
10 the applications leading to the '683, '721, and '861 patents were allowed, InterTrust could have
11 easily complied with the appropriate requirement yet chose not to. Here, the '107 application is
12 the "referenced application." The '107 application, in fact, NEVER issued as a patent – so the
13 examiner had no duty to substitute. It is the duty of the applicant to comply with the 112
14 requirements. *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942). Accordingly,
15 InterTrust should have either taken one of the two simple options that was open to it. It chose not
16 to. Its effort to incorporation by reference was ineffective.

17 **VII. CONCLUSION**

18 For the reasons set forth above, in Microsoft's opening brief and supporting
19 documents and any argument that may be provided at the hearing, Microsoft respectfully ask this
20 Court to grant its motion and find the mini-*Markman* claims to be invalid.

21 Dated: April 21, 2003

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